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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,404	10/28/2003	Richard Guy Gutman	440824/PALL	9221

23548 7590 03/06/2006  
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EXAMINER

SAVAGE, MATTHEW O

ART UNIT PAPER NUMBER

1724

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/694,404

Applicant(s)

GUTMAN ET AL.

Examiner

Matthew O. Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 December 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) 2-29 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

Newly submitted claim 2-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Original claim 1 is to a subcombination including a housing and filter element;

New claims 2-20 are to combinations including a housing, filter element, and valve;

The combinations do not include the particulars of filter element having a water wettable filter medium as required by the combination.

The subcombination has use with other combinations, for example, in housing applications requiring additional flow connections not having any valves.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 2-20 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schiavo et al in view of the "Filter Reference Guide" and the "Pall Selection Guide FLUORODYNE FILTERS (P GRADE)".

With respect to claim 1, Schiavo et al disclose discloses a plastics housing 30, 50 (see FIG. 1 and lines 51-58 of col. 1) providing an inlet port 32 and an outlet port 34, the material of the housing being such that the assembly can be sterilized by subjecting the interior of the housing to steam under pressure while the exterior of the housing is at atmospheric pressure without damaging the housing since it is capable of operating at a temperature of 190 degrees Celsius and a pressure of 5 bars, a filter element 20 held in the housing, the filter element having filter medium including a central passage extending between first and second ends of the filter medium (see FIG. 2), an end 22 of the filter element providing a fluid connection between the central passage and the port 34. Schiavo et al fail to specify the filter media as being formed of a water wettable material, the first end of the filter medium being embedded in a first end cap of a plastics material at a first joint to close the passage and the second end of the filter medium being embedded in a second end cap of a plastics material at a second joint, the characteristics of the filter medium at the joints not being materially changed, and the first and second end caps forming respective water-wettable joints with the filter medium. The Filter Reference Guide and the Pall Selection Guide together suggest filter media as being formed of a water wettable material (e.g., PVDF, see the third page of the Filter Reference Guide), the first end of the filter medium being embedded (e.g., via melt sealing) in a first end cap of a plastics material (e.g., PP, see the first page of the

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Pall selection guide) at a first joint to close the passage and the second end of the filter medium being embedded in a second end cap of a plastics material at a second joint, the characteristics of the filter medium at the joints not being materially changed and the first and second end caps and forming respective water-wettable joints with the filter medium since the filter element is formed of the same materials and in the same manner as the filter element disclosed by applicant on pages 10-11 of the instant specification. The Pall Selection Guide suggests that such a filter element provides superior bacteria and particle removal efficiency in demanding environments. It would have been obvious to have modified the filter of Schiavo et al so as to have included the filter element as suggested by the "Filter Reference Guide" and the "Pall Selection Guide" in order to provide a filter medium capable of providing superior bacteria and particle removal efficiency in demanding environments.


Applicant's arguments filed 12-8-05 have been fully considered but they are not persuasive.

Applicant argues that there is not sufficient motivation to combine the references used to reject instant claim 1, however, it is held that one skilled in the art would combine the references since they all are directed to filters for filtering hot liquids. Applicant's argument that there is no motivation to combine the prior art since the prior art does not address the same problem as applicant is not agreed with since the problem solved by prior art does not have to be the same as that solved by applicant for an obviousness rejection to be proper .

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O. Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

  
Matthew O Savage  
Primary Examiner  
Art Unit 1724

mos  
March 2, 2006